UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
VO, CECILE H

ART UNIT	PAPER NUMBER
2169	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

	Application No.	Applicant(s)
	10/583,273	YOSHIKAWA, TADASHI
Office Action Summary	Examiner	Art Unit	
	CECILE VO	2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>17 June 2008</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-26</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-26</u> is/are rejected.

7)☒ Claim(s) <u>7, 13-19 and 25-26</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to the Applicants' amendment received on

06/17/2008.

Claim Status

2.   Claims 1-3, 7, 12-16, 18, 20, 25 and 26 are amended.

3.   Claims 1-26 are currently presenting for examination, with claims 1, 2, 7, 13, 14,

15, 20, 25 and 26 being independent.

Claim Objections

4.   Applicant's amendments to objection of claims 12-13 and 25-26 are

acknowledged. Therefore, objections to the claims are withdrawn.

Claim Rejections – 35 USC §101

5.   Applicant's amendments to rejections of claims 7 and 20 under 35 U.S.C 101 are

acknowledged. However, examiner is not persuaded. Claims 7 and 20 is directed to a

system comprising software per se. Software per se is not one of the four categories of

invention. Software per se is not a series of steps or acts and thus is not a process.

Software per se is not a physical article or object and as such is not a machine or

manufacture. Software per se is not a combination of substances and thus, is not a

composition of matter. Therefore, the examiner maintains the rejections to the claims.

Duplicated Claims Objections

6.   Claims 7, 13-19 and 25-26 are objected to under 37 CFR 1.75 as being a

substantial duplicate of claims. When two claims in an application are duplicates or else

are so close in content that they both cover the same thing, despite a slight difference in

wording, it is proper after allowing one claim to object to the other as being a substantial

duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 7 is objected to under 37 CFR 1.75 as being a substantial duplicate of

claims 12 and 13.

Claims 13 is objected to under 37 CFR 1.75 as being a substantial duplicate of

claim 12.

Claim 14 is objected to under 37 CFR 1.75 as being a substantial duplicate of

claim 1.

Claim 15 is objected to under 37 CFR 1.75 as being a substantial duplicate of

claim 2.

Claims 16-19 are objected to under 37 CFR 1.75 as being a substantial duplicate

of claims 3-6.

Claims 25 and 26 are objected to under 37 CFR 1.75 as being a substantial

duplicate of claims 12 and 13.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8.   Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention.

In claims 1, 2, 7, 12-15, 20, 25 and 26, the added feature of the claims recite "*a

code **which is possessed on said image**" is not supported by the original disclosure. The

examiner has scanned the specification, but found no support for the limitation as

shown in independent claims 1, 2, 7, 12-15, 20, 25 and 26. Therefore, the limitation will

not be addressed since the examiner unable to determine the metes and bounds of the

limitation.

Claims 3-6, 8-11, 16-19 and 21-24 are rejected for the same reason, due to their

dependence on the above rejected claims.

9.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

10.   Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claims 1-26 are also vague and indefinite because it unclear to the Examiner the

relationship of independent and dependent claims and one of ordinary skill in the art

would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 101

11.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

12.   Claims 7-11 and 20-24 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

Claims 7 and 20 are directed to a system comprising software per se. Software

per se is not one of the four categories of invention. Software per se is not a series of

steps or acts and thus is not a process. Software per se is not a physical article or

object and as such is not a machine of manufacture. Software per se is not a

combination of substances and thus, is not a composition of matter.

Claims 8-11 and 21-24 are rejected for the same reason, due to their

dependence on the above rejected claims.

Claim Rejections - 35 USC § 102

13.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

14.   Claims 1-3, 5-16 and 18-26 are rejected under 35 U.S.C. 102(e) as being

anticipated by Igarashi et al. (hereinafter referred to as Igarashi), US Pub. Number

2004/0122866A1.

Regarding claim 1, Igarashi discloses a data storage device having a storage means for storing acquired data in a hierarchical structure (see abstract, lines 1-5), comprising:

an image pickup unit for picking up an image (e.g. photographing equipment such as a digital camera and a camera-fitted cellphone, §0031, lines 12-14);

an extraction means for extracting a piece of code information which is possessed on said image from a piece of image data acquired by picking up an image by the image pickup unit (e.g. the common defined information among plural image data is extracted to be the folder name, §0069, lines 6-7. In the defined information reading means of the file control program, image data "DSCN001.jpg or the like (as *a piece of code information*) in folder of a data provider are analyzed, and defined information recorded previously in or attached to respective image data are read, §0068, lines 1-5); and

a name generation means for generating a folder name or a file name relating to the piece of image data based on the piece of code information extracted by the extraction means (e.g. in the folder name generating means, a name of the folder that stores therein image data is generated in accordance with a rule determined beforehand, referring to defined information obtained through reading, §0069, lines 1-3 and 9-11).

Regarding claim 2, Igarashi discloses a data storage device having a storage means for storing acquired data in a hierarchical structure (see abstract, lines 1-5), comprising:

an image pickup unit for picking up an image (e.g. photographing equipment such as a digital camera and a camera-fitted cellphone, §0031, lines 12-14);

a code recognition unit having a table in which pieces of code information is respectively corresponded to a plurality of pieces of image data (e.g. the image data are generated by a camera maker in its own form, in the case of a digital camera (i.e. DCF, DPOF, EXIF and Picture CD forms), §0065, lines 1-13);

an extraction means for extracting a piece of the code information which is possessed on said image, from the table, corresponding to a piece of the image data acquired by picking up an image by the image pickup unit (e.g. a folder name creating means that creates the name of the folder that controls a file from the defined information that was read from file in specific forms such as DCF, DPOF, EXIF and Picture CD forms, §0067, lines 3-13. The folder name generating also mean , a name of the folder that stores therein image data is generated in accordance with a rule (for example, the priority order of defined information is determined, and the defined information having the common defined information among plural image data is extracted to be the folder name, §0069, lines 1-7); and

a name generation means for generating a folder name or a file name relating to the piece of the image data based on the piece of the code information extracted by the extraction means (e.g. in the folder name generating means, a name of the folder that

stores therein image data is generated in accordance with a rule determined

beforehand, referring to defined information obtained through reading, §0069, lines 1-3

and 9-11).

Regarding claim 3, Igarashi discloses the data storage device, further comprising

a determination means for determining whether or not the piece of the code information

is extracted by the extraction means, wherein when the determination means

determines that the piece of the code information is not extracted by the extraction

means, the name generation means generates the folder name or the file name relating

to the piece of the image data based on predetermined information (0062, lines 1-5) .

Regarding claim 5, Igarashi discloses the data storage device, further

comprising:

a folder generation means for generating in the storage means a folder of the

folder name generated by the name generation means (§0069, lines 1-3) ; and

a name changing means for changing the folder name or the file name relating to

data stored in the storage means, to the folder name or the file name generated by the

name generation means (§0052, lines 4-15).

Regarding claim 6, Igarashi discloses the data storage device, further comprising

a reception means for receiving a selection of a first or second processing, wherein

when the reception means receives the selection of the first processing, the folder

generation means generates in the storage means the folder of the folder name
generated by the name generation means (§0062, lines 1-5) , and when the reception
means receives the selection of the second processing, the name changing means
changes the folder name or the file name relating to the data stored in the storage
means, to the folder name or the file name generated by the name generation means
(§0063, lines 1-11).

Regarding claim 7, Igarashi discloses an information transmitter that transmits
information to outside, comprising:

an image pickup unit for picking up an image (e.g. photographing equipment
such as a digital camera and a camera-fitted cellphone, §0031, lines 12-14);

a code acquisition means for acquiring a code which is possessed on said image
from a piece of image data obtained by picking up an image by the image pickup unit
(e.g. the image data are generated by a camera maker in its own form, in the case of a
digital camera (i.e. DCF, DPOF, EXIF and Picture CD form), §0065, lines 1-13);

an analyzing means for analyzing the code acquired by the code acquisition
means and acquires a piece of code information (e.g. in the defined information reading
means of the fie control program, image data ("DSCN0001.jpg" or the like - as a piece
of code information) in folder of a data provider are analyzed and defined information
recorded previously in or attached to respective image data are read, §0068, lines 1-5);
and

a transmission means for transmitting to outside the piece of code information acquired by the analyzing means (e.g. the defined information is one determined in advance in accordance with a form of the file, and its concrete example to be uses, §0068, lines 6-8).

Regarding claim 8, Igarashi discloses the information transmitter, further comprising:

a display means for displaying the piece of code information acquired by the analyzing means (§0004, lines 1-9); and

an instruction reception means for receiving an instruction whether or not the piece of code information displayed on the display means is transmitted, wherein the transmission means transmits the piece of code information when an instruction to transmit the piece of code information is received by the instruction reception means (§0004, lines 1-9).

Regarding claim 9, Igarashi discloses the information transmitter, further comprising an encoding means for encoding the piece of code information acquired by the analyzing means, wherein the transmission means sends the piece of code information encoded by the encoding means (e.g. image data are displayed on an at sight basis by an application in many cases, and in that case, thumbnail image data wherein a data size of image data is reduced is used, §0055, lines 4-7).

Regarding claim 10, Igarashi discloses the information transmitter, further comprising:

a plurality of analyzing means respectively corresponding to different codes (§0041, lines 1-6); and

a selection means for selecting, based on the code acquired by the code acquisition means, an analyzing means to analyze the code from the plurality of analyzing means (§0051, lines 7-21), wherein

the analyzing means selected by the selection means analyzes the code acquired by the code acquisition means (§0051, lines 1-21).

Regarding claim 11, Igarashi discloses the information transmitter, further comprising a storage means for storing the code acquired by the code acquisition means and the piece of code information acquired by analyzing the code by the analyzing means, for each analyzing means selected by the selection means (§0041, lines 1-15).

Regarding claim 12, Igarashi discloses a data storage system (e.g. computer device, Fig. 1), comprising:

an information transmitter (e.g. the Bus 5 in Fig. 1) that transmits information to outside, comprising:

an image pickup unit for picking up an image (e.g. photographing equipment such as a digital camera and a camera-fitted cellphone, §0031, lines 12-14);

a code acquisition means for acquiring a code which is possessed on said image from a piece of image data obtained by picking up an image by the image pickup unit (e.g. the image data are generated by a camera maker in its own form, in the case of a digital camera (i.e. DCF, DPOF, EXIF and Picture CD form), §0065, lines 1-13);

an analyzing means for analyzing the code acquired by the code acquisition means and acquires a piece of code information (e.g. in the defined information reading means of the fie control program, image data ("DSCN0001.jpg" or the like - as a piece of code information) in folder of a data provider are analyzed and defined information recorded previously in or attached to respective image data are read, §0068, lines 1-5); and

a transmission means for transmitting to outside the piece of code information acquired by the analyzing means (e.g. the defined information is one determined in advance in accordance with a form of the file, and its concrete example to be uses, §0068, lines 6-8); and

a data storage device for storing data in a hierarchical structure (e.g. memory 2 in Fig. 1), the data storage device comprising:

a reception means for receiving the piece of code information transmitted from the information transmitter (§0035, lines 1-29); and

a name generation means for generating a folder name or a file name relating to the data, based on the piece of code information received by the reception means (§0069, lines 1-3).

Regarding claim 13, Igarashi discloses an information processing system, comprising:

an information transmitter (e.g. the Bus 5 in Fig. 1) that transmits information to outside, comprising:

an image pickup unit for picking up an image (e.g. photographing equipment such as a digital camera and a camera-fitted cellphone, §0031, lines 12-14);

a code acquisition means for acquiring a code which is possessed on said image from a piece of image data obtained by picking up an image by the image pickup unit (e.g. the image data are generated by a camera maker in its own form, in the case of a digital camera (i.e. DCF, DPOF, EXIF and Picture CD form), §0065, lines 1-13);

an analyzing means for analyzing the code acquired by the code acquisition means and acquires a piece of code information (e.g. in the defined information reading means of the fie control program, image data ("DSCN0001.jpg" or the like - as a piece of code information) in folder of a data provider are analyzed and defined information recorded previously in or attached to respective image data are read, §0068, lines 1-5); and

a transmission means for transmitting to outside the piece of code information acquired by the analyzing means (e.g. the defined information is one determined in advance in accordance with a form of the file, and its concrete example to be uses, §0068, lines 6-8) ; and

an information processor for performing a predetermined processing based on the piece of code information transmitted from the information transmitter (e.g. CPU 4 in Fig. 1).

Claims 14-19 are similar to claims 1-6, therefore, claims 14-19 are rejected by the same reasons as discussed above.

Regarding claim 20, Igarashi discloses an information transmitter that transmits information to outside, comprising:

an image pickup unit for picking up an image (e.g. photographing equipment such as a digital camera and a camera-fitted cellphone, §0031, lines 12-14);

a code extraction unit for acquiring a code which is possessed on said image from a piece of image data obtained by picking up an image by the image pickup unit (e.g. data reading means 7, Fig. 2, that reads data through photographing equipment, §0035, lines 5-6);

a decoding unit for analyzing the code thus acquired and acquires a piece of code information (e.g. data control structures 8 and 9, Fig. 2); and

a communication unit for transmitting the acquired piece of code information to outside (e.g. communication network, §0035, lines 18-19).

Regarding claim 21, Igarashi discloses the information transmitter, further comprising:

a display unit for displaying the acquired piece of code information (e.g. monitor in Fig. 15); and

an operation unit for receiving an instruction whether or not the displayed piece of code information is transmitted (e.g. CPU in Fig. 4), wherein

the communication unit transmits the piece of code information when an instruction to transmit the piece of code information is received (e.g. communication network in Fig. 15).

Regarding claim 22, Igarashi discloses the information transmitter, further comprising a controller capable of encoding the acquired piece of code information (e.g. data control structures 8 and 9, Fig. 2), wherein

the communication unit transmits the encoded piece of code information (e.g. communication network in Fig. 15).

Regarding claim 23, Igarashi discloses the information transmitter, wherein

the decoding unit includes a plurality of decoders respectively corresponding to different codes, for analyzing the acquired code to acquire the piece of code information (§0041, lines 1-6), and

the information transmitter further comprises a decoder selection unit for selecting, based on the code acquired by the code extraction unit, a decoder to analyze the code from the plurality of decoders (§0055, lines 4-7), wherein

the decoder selected by the decoder selection unit analyzes the code acquired by the code extraction unit (e.g. data control structure 9 in Fig. 2).

Regarding claim 24, Igarashi discloses the information transmitter, further comprising a controller capable of storing the code acquired by the code extraction unit and the piece of code information obtained by analyzing the acquired code, for each decoder selected by the decoder selection unit (e.g. data control structure 8 and 9 in Fig. 2).

Claims 25-26 are similar to claims 12-13, therefore, claims 25-26 are rejected by the same reasons as discussed above.

Claim Rejections - 35 USC § 103

15.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16.   Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igarashi et al. (hereinafter referred to as Igarashi), US Pub. Number 2004/0122866A1 above, and further in view of Hatanaka, US Patent Number 6,438,320 B1.

Regarding claims 4 and 17, Igarashi does not explicitly discloses:

reporting a message that the piece of code information is not extracted, when determining accordingly.

Hatanaka teaches: the file structure in the memory area of the card is examined and a check is made to see if the file of the file name exists in the route directory. If the file of such a file name exists, since the director of the same name cannot be formed, and a message to notify the user of the reason id displayed on a display apparatus (Hatanaka: col. 6, lines 1-7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the data control structure discloses by Igarashi with reporting a message as shown by Hatanaka in order to manage the file structure of a storage device.

Response to Arguments

17.   Applicant's amendments filed 06/17/2008 have been fully considered but they are unpersuasive, therefore, this action has been made **FINAL**.

In response to Applicant's argument "Igarashi et al. has no disclosure or suggestion regarding *extracting a piece of code information which is possessed on said image from a piece of image data*...". The Examiner respectfully submits that the added limitations in the amended claims are unclear and are addressed in the rejection under 112 first and second paragraphs above.

Applicants also asserted that "*Hatanaka fails to cure the deficiencies of Igarashi*". However, the Applicants are silent on the ground the Examiner set forth for 35 USC 103(a) rejections. The Examiner hereby respectfully maintaining the same grounds of rejections as set forth in the Non-Final rejection of 03/17/2008.

Conclusion

18.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to CECILE VO whose telephone number is (571)270-3031.

The examiner can normally be reached on Mon - Thu (9AM - 5:00PM EST).

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tony Mahmoudi can be reached on 571-272-4078. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

        Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 29, 2008   /Cecile Vo/
                                            Examiner
                                            Art Unit 2169

/H. Q. P./
Primary Examiner, Art Unit 2169

/Tony Mahmoudi/

Supervisory Patent Examiner, Art Unit 2169